

REMARKS

Claims 1-3, 6, 8, 10, 12, 14, 16, 18, 20, 22, 24, 26, and 28 are pending in the present application. By virtue of this amendment, claims 1, 6, 10, 18 and 22 have been amended without prejudice or disclaimer of any previously claimed subject matter.

Rejections under 35 U.S.C. § 112, second paragraph

The Office has rejected claims 1-3, 6, 8, 10, 12, 14, 16, 18, 20, 22, 24, 26 and 28 as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, this claim has been amended to clarify that the gate electrode receives the first input signal which influences the channel region through a gate insulating film.

The reasoning for the remainder of the indefiniteness rejection is essentially the same -- that the "a pair" terminology is unclear. Applicant submits that it is clear, from the context, that the "pair" is referring to one P-type semiconductor element paired with a N-type semiconductor element. Without interpreting this portion of the claims in that manner, the remainder of those claims is somewhat unclear. This has been recognized by the Examiner. Applicant acknowledges that this interpretation is more clear in claim 22, for example, than the other claims cited by the Examiner.

not OK In any event, Applicant has amended claims 6, 10, 18 and 22 to remove the "pair" language. It is respectfully submitted that, because the meaning of these claims was already clear. None of the amendments submitted herein are for the purpose of distinguishing over prior art relied upon in rejecting the claims and, thus, none of the amendments implicate a need to perform further searching.

Rejections under 35 U.S.C. § 103(a)

A. The Office has rejected claims 1-3 as allegedly being unpatentable over Okumura et al. (JP 08-204140). Applicant once again respectfully traverses the rejection.

In Applicant's previous response (filed January 3, 2003), Applicant argued that Okumura fails to disclose "the first and second input signals are different signals that are synchronized with each other" as recited in amended claim 1. The Examiner alleges that "Since the device structure of Okumura et al. is similar to that of the claimed structure, it is believed that the device structure of Okumura et al. is able to support a circuit that would require the first and second input signals having different signals that are synchronized with each other."

The Examiner's reasoning is flawed in a number of regards. First, while perhaps the structure of Okumura is "similar" to that of the claimed structure (an allegation on which Applicant need not presently take a position), the Examiner must consider the reference for all that it teaches, including portions that teach away from what is claimed. Second, in making an obviousness rejection, the Examiner may not consider the teachings of the present patent application under examination. Third, Applicant asserts that the Examiner's "belief" that the Okumura device "is able" to support a "similar" structure is misplaced. We now discuss each of Applicant's assertions of the previous paragraph in order.

With respect to teaching away, it is well-established law that, in making an obviousness rejection, the Examiner must consider a reference for all that it teaches, including those portions that teach away from the claimed invention. See, e.g., *In re Haruna*, 249 F.3d 1327, 58USPQ2d 1517 (Fed. Cir. 2001) ("A prima facie case of obviousness can be rebutted if the applicant...can show that the art in any material respect 'taught away' from the claimed invention. A reference may be said to teach away when a person of ordinary skill, upon reading the reference...would be led in a direction divergent from the path that was taken by the applicant." Applicant has shown, in the previous response, why Okumura should be considered to teach away from what is claimed. Basically, without repeating the detailed discussion in the previous response, the input voltages to the bases of the PMOS and NMOS transistors of Okumura are such that the first and second input signals are not (and would not be) synchronized with each other. The Examiner's only (apparent) refutation of Applicant's showing is that "It would have been obvious for the first and second input signals are different signals that are synchronized with each other because

they depend on the function of the circuit.” The Examiner completely ignores the portion of Okamura that teaches away from the proposed modification.

Furthermore, it is clear that the Examiner has ignored the cardinal rule of obviousness rejections, that an obviousness rejection must be supported by some teaching or suggestion in the cited references, or by knowledge held by one of ordinary skill in the art, to make the proposed modification or combination. This leads directly to the second regard in which the Examiner’s reasoning is flawed.

That is, rather than provide the required support, the Examiner has resorted to the unsupported proposition that the modification would have been obvious because the signals “depend on the function of the circuit.” What the Examiner seems to be saying, then, is that one might choose the particular signals recited in the claims. However, there is nothing in Okamura that discloses or suggests that one would choose these signals. Rather, the Examiner has read Applicant’s specification, gleaned that Applicant discloses particular types of signals, and has then impermissibly employing the hindsight gained from Applicant’s specification to determine that “it would be obvious” to use such signals in the Okamura circuit.

Finally, we discuss why the Examiner’s “belief” that the Okamura device “is able” to support a “similar” structure is misplaced. The Examiner has pointed to nothing in the Okamura disclosure to substantiate this “belief.” To the extent that the Examiner is relying on personal knowledge (the use of the word “belief” suggests that the Examiner is), Applicant respectfully requests the Examiner to provide an affidavit of personal knowledge in accordance with 37 CFR 1.107(b). However, as discussed above, even if the Examiner substantiates the “belief” with an affidavit of personal knowledge, that Okumaura (allegedly) “is able to support a circuit that would require the first and second input signals,” as recited in the claims, is not enough to support a prima facie case of obviousness. Put simply, that a prior art reference is “able to support” a particular feature recited in a claim is not evidence that such a feature is obvious.

This is very much in line with recent court decisions. Recent court decisions provide that in order to establish a prima facie case of obviousness based on a combination of references,

there must be some teaching, suggestion, or motivation to combine the reference teachings. The teaching, suggestion, motivation must come from the prior art or the knowledge of one of ordinary skill in the art, but not from the Applicant's invention.

Further, there must be some reason, **within the reference**, that would lead one of ordinary skill to combine the reference teachings. **Examiner is required to specifically identify reasons why one would have been motivated to select and combine reference teachings** (In re Dembiczak: 1999). **The reasons for the rejections must not rely on assumptions**, as the Examiner did in the outstanding office action.

OK Further, even though a 103 rejection can be made using a **single prior art reference**, the rejection still requires some showing of a suggestion or motivation to combine teachings of the portions of the reference (In re Kotzab, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000)).

OK For at least the reasons discussed above, it is respectfully submitted that the obviousness rejection of claims 1-3 is improper and should be withdrawn.

B. The Office has rejected claims 1-3, 6, 8 and 14 as allegedly being unpatentable over Chang et al. in view of Iwamatsu.

In response, Applicant respectfully submits that neither Chang nor Iwamatsu, alone or in combination, include all of the elements recited in the claims. In the response to Applicant's remarks, the Examiner states that Figure 4 of Iwamatsu discloses, at each well, "second input signals . . . are different signals that are synchronized with each other." However, what is recited in the claim is that the first input signal is received by the gate terminal (fabricated on a channel region) and the second input signals is received by the substrate terminals.

not true. Put another way, the Examiner appears to be alleging that the one second input signal (received at one substrate terminal) is synchronized with a different second input signal (received at a second substrate terminal). The Examiner's allegation does not consider at all the

relationship between a first input signal (received by a gate terminal fabricated on a channel region) and second input signals received at substrate terminals.

In addition, Applicant submits that Chang and Iwamatsu are improperly combined. The fact that two disclosures "teach" the same general type of device is not proper motivation to combine the devices. The Examiner has not provided any suggestion or motivation to make the combination, whether "because they provide a CMOS level shifter circuit having" or otherwise. Clearly, the Examiner only combines Chang and Iwamatsu based on impermissible hindsight gleaned from Applicant's specification.

Thus, Applicant once again respectfully contends that the obviousness rejection is improper and should be withdrawn.

Allowable Subject Matter

The Examiner has indicated that 22, 24, 28, 10 and 18 include allowable subject matter. While Applicant appreciates this indication, Applicant has chosen at this time to not rewrite the claims. Rather, it is submitted that, as discussed above, all of the claims include allowable subject matter.

CONCLUSION

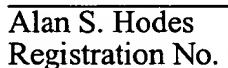
Applicant has, by way of the remarks presented herein, made a sincere effort to overcome rejections and address all issues that were raised in the outstanding Office Action. Accordingly, reconsideration and allowance of the pending claims are respectfully requested. If it is determined that a telephone conversation would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicant(s) petition(s) for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 247322001700.

Respectfully submitted,



Dated: May 5, 2003

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